REMARKS/ARGUMENTS

Claims 1-20 and 25-28 are pending in this application. By this Amendment, claims 1 and 6 are amended and claims 2-5 are canceled without prejudice or disclaimer. Reconsideration in view of the above amendments or the following remarks is respectfully requested.

A. The July 3, 2006 Office Action incorrectly identifies dependent claims 25-28 as directed to Figure 4 in Item 1 on page 2 of the Office Action. In contrast, Applicant respectfully submits since claim 25 recites a plurality of digital contents, e.g., stored, requested and transmitted (see block S100), and claims 26-28 recite features of a sequence file, inter-related advertisement contents and service unit data, Applicant respectfully submits that claims 25-28 are drawn to Figure 3 and therefore are a part of the elected invention. Applicant requests the Office Action to clearly show portions in the specification that support the assertion claims 25-28 do not read on and thus are not directed to Figure 3.

Consideration of claims 25-28 is respectfully requested.

B. The Office Action maintains the rejection of claims 1-6 under 35 U.S.C. §112, second paragraph because the claimed features are not clear with respect to the

descriptive portion of the specification and the drawings. The rejection is respectfully traversed.

Below is a listing of claims 1-6 with references to the specification and figures that show descriptive support for the claimed features in exemplary portions of the specification and exemplary correlations to the figures. Thus, Applicant respectfully submits that claims 1-6 are definite under 35 U.S.C. §112, second paragraph.

1. (Previously Presented) A method of providing digital contents, comprising:

a first step of storing digital contents each constructed with a plurality of service unit data and a plurality of advertisement contents **(paragraph 58, lines 2-4; Fig. 3, block S1)**; and

a second step of outputting the stored service unit data and the stored advertisement contents alternately through one transmission path **(paragraph 58, lines 14-18; Fig. 3, blocks S6-S9)**.

2. (Previously Presented) The method of claim 1, wherein the first step further comprises:

storing a sequence file indexed to regulate a transmission order for the plurality of service unit data of a selected one of the digital contents **(paragraph 58, lines 5-6; Fig. 3, block S2)**; and

inter-relating at least one of the advertisement contents to each index of the sequence file to store the inter-related advertisement contents as the advertisement contents of each service unit data of the selected digital content **(paragraph 58, lines 7-12; Fig. 3, block S3)**.

3. (Original) The method of claim 2, wherein when a specific index of the sequence file is requested, the method further comprises **(paragraph 59, lines 4-5; Fig. 3, block S5)**:

outputting the inter-related advertisement contents of the specific index **(paragraph 59, lines 5-6; Fig. 3, block S6)**; and

making the service unit data of the specific index stand by for output **(paragraph 59, line 7; Fig. 3, block S7)**.

4. (Previously Presented) The method of claim 3, further comprising outputting the service unit data standing by for output, when an acknowledgment by a user for the outputted advertisement contents of the specific index is received **(paragraph 60, lines 4-5; Fig. 3, blocks S8-S9)**.

5. (Previously Presented) The method of claim 4, further comprising measuring a popularity of the digital contents by referring to a number of acknowledgments received regarding each of the plurality of advertisement contents that were outputted corresponding to the plurality of service unit data of the digital contents **(paragraph 61, lines 1-3; Fig. 3, block S100)**.

6. (Original) The method of claim 3, further comprising outputting the service unit data standing by for output after a predetermined time elapses after the output of the advertisement contents of the specific index **(paragraph 61, lines 3-6; Fig. 3, block S9)**.

Withdrawal of the rejection of 1-6 under 35 U.S.C. §112 is respectfully requested.

C. The Office Action rejects claims 1-6 under 35 U.S.C. §112, first paragraph for failing to comply with the written description requirement. The rejection is respectfully traversed.

In particular, the July 3, 2006 Office Action asserts amended lines 2-3 of claim 1 are not supported by the original specification between paragraphs 48 and 62. Applicant respectfully disagrees.

Lines 2-3 of claim 1 recite "a first step of storing digital contents each constructed with a plurality of service unit data and a plurality of advertisement contents."

Applicant respectfully submits that an exemplary system for transmitting digital contents (e.g., a digital e-book) is shown in Fig. 2A where a server 20 includes input/output module 21 controlling the inter-operation of databases 30 and 31 (see paragraph 51, lines 3-5). E-book database 30 can store a plurality of digital e-book contents. Each of the digital e-book contents is constructed with a plurality of transmission units (e.g., service units such as a page or chapter of an e-book) classified according to an amount of data that may be transmitted at once (see paragraph 48, lines 1-4). Advertising database 31 can store a plurality of advertising contents therein (see paragraph 49). Contents library 24 can inter-relate the advertising contents to each e-book (e.g., digital content) index of transmission unit data, creating a sequence file to regulate an output order of the inter-related information. The output order can be structured so that at least one of the advertising contents is inserted between each consecutive pair of the transmission unit data constructing each of the e-book contents (see paragraph 52, lines 9-13).

Applicant respectfully submits that lines 2-3 of claim 1 and the remainder of claim 1 comply with the written description requirement.

Additional, independent exemplary support for claim 1 is provided by at least Figures 3-9, respectively. See at least Blocks S1-S3, S10, S30-S31, S50-S51, S70-S71, S80 and S90, respectively.

Applicant respectfully submits that claims 2-6 depend from claim 1 and comply with the written description requirement. Withdrawal of the rejection of claims 1-6 under §112, first paragraph is respectfully requested.

D. The Office Action rejects claims 1-6 under 35 U.S.C. §103(a) over U.S. Patent No. 6,944,585 to Pawson. See Item 5, lines 1-2 of the July 3, 2006 Office Action. Since Pawson does not disclose or suggest features recited in the pending claims, the rejection is respectfully traversed.

The Patent Office bears the initial burden of proving a prima facie conclusion of obviousness. MPEP § 2142. The required elements of proof are: 1) a suggestion or motivation to modify or combine references, 2) a reasonable expectation of success, and 3) the references must teach or suggest all the claim limitations. MPEP § 2143.

1) Applicant respectfully submits that claim 1 is not properly rejected over Pawson because Pawson does not teach or suggest recited features of the claimed invention. For example, Pawson provides a customized content in accordance with the information of a user. That is, if the user purchases a truck, a content resolver 145 includes a commercial

for an automobile theft deterrent device in an audio-visual data stream and transmits the commercial for an automobile theft deterrent device to the user. Also, if the user is tardy on his bill, the content resolver 145 includes a reminder notice in an audio-visual data stream and transmits the reminder notice to the user. See column 5, line 47-column 6, line 4 of Pawson.

In contrast, embodiments of the invention transmit a service unit data and advertisement contents alternately. That is, embodiments of the invention transmit the service unit data and the advertisement contents alternately according to a "predetermined rule" without customizing contents according to the user's information.

Applicant respectfully submits that a "predetermined rule" without customizing contents according to the user's information is recited, for example, in claim 26 where the stored inter-related advertising contents are determined to according to a price of the corresponding digital content or a priority of said each service unit data. Similarly, dependent claim 27 recites a "predetermined rule" as a prescribed relationship or transmitted entirely or in a time proportionate to said at least one received acknowledgment responses. Further, since claim 25 recites a plurality of digital contents, e.g., stored, requested and transmitted (see block S100), and claims 26-28 recite features of a sequence file, inter-related advertisement contents and service unit data, Applicant

respectfully submits that claims 25-28 are drawn to Figure 3 and therefore are a part of the elected invention.

2a) Although only rejected under §103 over Pawson, with respect to original claims 1-2, the December 6, 2005 (Item 6, lines 8-10) and July 3, 2006 Office Actions appear to take Official Notice that features of "storing digital content" and "inter-relating such content to an advertisement" and "outputting such content" has been common knowledge in the media art, and it would be obvious to modify Pawson with such features to result in the claimed invention.

2b) Further, the Final Office Action appears to assert that since Applicant's traversal was inadequate, the Official Notice statement in the December 6, 2005 Office Action can be admitted as prior art.

(i) Applicant respectfully notes that the April 6, 2006 Amendment traversed the rejection of claims 1-6 under 35 U.S.C. §103 and therefore clearly traversed the Official Notice on the record. Thus, adequate traversal (e.g., first step) of the attempted Official Notice with respect to claims 1-2 finding was satisfied by the April 6, 2006 Amendment.

(ii) Further, with respect to the Official Notice taken in both Office Actions, Applicant respectfully submits that Section 2144.03B states if Official Notice is taken of a fact, unsupported by the documentary evidence, the technical reasoning underlying a

decision to take such notice must be clear and unmistakable. Further, if such notice is taken the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion and common knowledge.

With a standard review applied to finding of facts set to the "substantial evidence" standard in MPEP 2144.03 (second paragraph), Applicant respectfully submits that both Office Action's attempted Official Notice was vague, not clear and unmistakable and has no factual findings as a basis for such a conclusory assertion is taken that "storing digital content" and "inter-relating such content to an advertisement" and "outputting such" is common knowledge. Thus, Applicant respectfully submits that both Office Actions do not satisfy the requirements for taking Official Notice set forth in MPEP 2144.03 and 2144.03(B).

(iii) As to specific statements why the Official Notice assertions in the December 6, 2005 Office Action were common knowledge in the media art, Applicant respectfully submits that the April 6, 2006 Amendment asserted 1) Pawson did not disclose these features; 2) Pawson was the only applied prior art; and 3) the application and inventor set forth a detailed description why such features are believed novel. Thus, the April 6, 2006 Amendment asserted the Official Notice that "storing digital content" and "inter-relating

such content to an advertisement" and "outputting such" is common knowledge was improper. For those specific reasons, Applicant respectfully requested production of 1) a secondary reference that would teach these features or 2) an affidavit that such knowledge was in the content of the Examiner. Applicant laid out why Pawson did not disclose the asserted "common knowledge" reasons Applicant considered the recited features were novel and cannot refute a secondary reference that was not applied. In addition, Applicant requested a secondary reference to teach such features and reasons to modify Pawson. Thus, Applicant respectfully submits that MPEP §2144.03C were satisfied by the April 6, 2006 Amendment.

2c) Finally, even if Applicant's traversal was inadequate and the "Official Notice" statements in the first Office Action was taken to be admitted as prior art, Applicant respectfully submits that only "storing digital content" and "inter-relating digital content to an advertisement" and "outputting such" as recited in claims 1 and 2 has been admitted. Thus, Applicant respectfully traverses any additional Official Notice that the July 3, 2006 Office Action is taking, and provides additional reasons such features are not in the prior art, for example, with respect to claims 1-6 as set forth below.

(i) With respect to claims 4 and 6, Applicant respectfully submits that Pawson does not disclose or suggest at least respectively recited features of using a "sequence file

indexed to regulate a transmission order" as recited in claim 2 and outputting the service unit data standing by for output, when an acknowledgment by a user for the outputted advertisement contents of the specific index is received or outputting the service unit data standing by for output after a predetermined time elapses after the output of the advertisement contents of the specific index. Pawson teaches away from a system of payment by advertising for selected digital contents. Pawson discloses payment by the user for the digital content (e.g., movie). See the Abstract and Figures 1-3 of Pawson. Pawson does not teach or suggest any modification to its disclosure to stop transmitting digital contents once transmission has begun. Thus, it would not be obvious to one of ordinary skill how or why to make such changes to Pawson.

(ii) With respect to claim 3, Pawson does not disclose at least features of making the service data unit standby for output and combinations thereof as recited. In contrast, Pawson discloses the user paying for the digital content, not user acknowledged viewing of selected "advertising" paying for digital content. Pawson does not disclose outputting the service data unit when an acknowledgment by a user for the advertisements of a specific index is received. In contrast, Pawson discloses payment is separated from transmittal of a portion of a digital content.

Further, as Pawson discloses payment is separated from transmittal of a portion of a digital content, Applicant respectfully submits it would not be obvious to modify Pawson to have such features. Namely, Pawson appears to disclose where payment is provided for a period of time wherein digital contents are transmitted upon selection by a user. Alternatively, Pawson discloses a pay per view feature. However, Applicant respectfully submits in neither situation does Pawson indicate that transmittal of a portion of digital content is related to watching and acknowledging the watching of an advertising content.

(iii) With respect to features of measuring a popularity of the digital contents by referring to a number of acknowledgments received regarding each of the plurality of advertisement contents that were outputted and combinations thereof as recited in original claim 5, Applicant respectfully submits that such features are not disclosed by Pawson. Further, as Pawson does not amend a pay structure based on popularity of a digital content nor does Pawson disclose modifying a priority of a digital content based on popularity, Applicant respectfully submits it would not be obvious to one of ordinary skill in the art to modify Pawson to incorporate "popularity" of digital contents let alone using advertisement to determine popularity.

Finally, since Pawson discloses a method to provide requested digital contents, Applicant respectfully submits that Pawson teaches away from using the acknowledged advertisement to determine popularity of digital contents. Pawson, at best, changes the ad according to the user profile. Thus, Applicant respectfully submits that there is no teaching or suggestion in the applied prior art that makes it obvious to modify Pawson as asserted by the Office Action with respect to at least features of inter-relating each index of the sequence file to store the inter-related advertisement contents as the advertisement contents of each service unit data of the selected digital content, wherein when a specific index of the sequence file is requested, the method further comprises outputting the inter-related advertisement contents of the specific index, and making the service unit data of the specific index stand by for output, further comprising outputting the service unit data standing by for output, when an acknowledgment by a user for the outputted advertisement contents of the specific index is received, further comprising measuring a popularity of the digital contents by referring to a number of acknowledgments received regarding each of the plurality of advertisement contents that were outputted corresponding to the plurality of service unit data of the digital contents and combinations thereof as recited in claim 1.

Thus, as there is no teaching or suggestion in Pawson and no indication that there would be benefit to Pawson for such modifications, Applicant respectfully submits that claim 1 defines patentable subject matter. The Office Action appears to take Official Notice that such features are common knowledge and to have implemented such features and common knowledge would be obvious to one of ordinary skill in the art. As described above, Applicant traverse the Official Notice.

As required by M.P.E.P. §2144.03, Applicant respectfully requests production of a secondary reference to support such a conclusion. If the secondary reference is not available, then a rejection must be based on facts within the personal knowledge of the Examiner. If this is the case, Applicant respectfully requests an Affidavit from the Examiner with the data stated as specifically as possible, in accordance with M.P.E.P. §2144.03. If neither a secondary reference nor an Affidavit can be produced, this rejection fails to meet the prima facie case of obviousness, and withdrawal of this rejection is respectfully requested. See, Ex Parte Natale, 11 U.S.P.Q. 2d 1222 (BPAI, 1989).

2d) For at least the reasons set forth above, Applicants respectfully submit that claim 1 defines patentable subject matter. Dependent claim 6 is allowable for at least the reasons discussed above with respect to independent claim 1, as well as for its added

features. Claims 2-5 are canceled without prejudice or disclaimer. Withdrawal of the rejection of claims 1-6 under 35 U.S.C. §103 over Pawson is respectfully requested.

D. The Office Action asserts claims 25-28 read on Figure 4. Applicant respectfully submits that that the previous Amendment indicated that claims 25-28 were described in paragraphs 57 to 62 of the present specification. As those paragraphs describe Figure 3, Applicant respectfully submits that these claims read on Figure 3, the elected invention. Accordingly, examination of claims 25-28 or an indication that these claims are allowable because they are not rejected in the July 3, 2006 Office Action, is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **Carl R. Wesolowski**, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of

this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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